IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of: Confirmation Number: 6988
CHRISTENSEN
Application No.: 09/315,822   Group Art Unit: 3622

Filed: May 21, 1999   Examiner: Jean D. Janvier

Title: VIRTUAL COUPONING METHOD AND APPARATUS FOR USE WITH
CONSUMER KIOSK

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL-BRIEF

Sir:

This is in response to the Notice of Non-Compliant Appeal Brief mailed March
27, 2005, wherein the Examiner indicated that the "Summary of Claimed Subject Matter"
was allegedly not properly presented according to 37 C.F.R. §41.37(c)(1)(v) in the
Appeal Brief filed January 23, 2006. The Applicant respectfully request entry of the
following compliant "Summary of Claimed Subject Matter" which begins on page 2 of
this paper.

It is not believed that extensions of time or fees for net addition of claims are
required beyond those that may otherwise be provided for in documents accompanying
this paper. However, if additional extensions of time are necessary to prevent
abandonment of this application, then such extensions of time are hereby petitioned for
under 37 C.F.R. § 1.136(a), and any fees required therefore (including fees for net
addition of claims) are hereby authorized to be charged to our Deposit Account No.
00909 (*Ref. No. 031792-0311520*)

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V.   Summary of Claimed Subject Matter - *37 C.F.R. §41.37(c)(1)(v)*

The following exemplary citations to the Specification and drawing figures are not exclusive, as other examples of support for the claimed subject matter may exist. As such, the following citations should not be viewed as limiting.

One aspect of Appellant's invention relates to an *in-store* system for generating and redeeming coupons (e.g., within a store or other retail location). *See* Specification, *e.g.*, pg. 1, line 1+. According to one aspect of the invention, the system includes means *at the retail location* (e.g. at the checkout) for determining whether the coupon is valid, *prior* to giving the consumer credit. The invention, in part, addresses problems of the prior art wherein a consumer was given a credit at the retail location (without checking the validity of the coupon) and subsequently the coupons were sent from the retailer to a coupon redemption center for processing, only then to learn the coupon was fraudulent. In some cases, these coupon processing centers[1] may have taken certain steps to determine the validity of the coupon, but clearly these steps were performed long after a consumer received credit for the coupon. So even if fraudulent activity was detected, it was after the consumer received the credit.

As detailed below, merely checking if the consumer has purchased a product for which the coupon is eligible does not identify whether the coupon itself is valid. Assuming a consumer purchases a product for which the consumer has coupon, this merely indicates that the product is "coupon eligible." The coupon may still be fraudulent.

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[1] It is well known that coupon redemption centers refer to locations where retailers sent coupons that have already been redeemed by consumers so that the retailer can receive credit from the coupon issuer for the discounts provided to the consumer (e.g., coupon clearing house.)

One common type of consumer coupon fraud occurs when a consumer makes multiple copies of the same coupon and tries to separately redeem the multiple copies. Other types of consumer coupon fraud exist. In this (and other scenarios), even if the consumer purchases a coupon eligible product, fraud may occur due to the unauthorized copying and multiple redemptions of the coupon (or copies) by the consumer. One aspect of the invention may include, among other things, a means at the retail location (e.g., at a retail location checkout) for counting the number of times the consumer redeemed a particular coupon and fraud indication means for indicating fraud if the number of times a coupon is redeemed by the consumer exceeds a predetermined amount. *See* Specification *e.g.,* pg. 45 lines 15-22. For example, in one implementation, a consumer may present a coupon at the retail location checkout where a bar code on the coupon is electronically scanned during checkout and a database is accessed, *prior to giving the consumer a credit for the coupon.* Data from the database (e.g., repository 126) may be read to determine whether the coupon is valid (e.g., has not been previously redeemed more than a predetermine number of times) before crediting the consumer with the value associated with the coupon. *See* Specification, *e.g.,* pg. 32, lines 11-19. Other validation steps may be performed. The recitation of "means for indicating fraud" may refer to, for instance, an error message (906). An error message (906) may be displayed to the user to indicate that fraud has been detected (e.g., based on exceeding the number of times a coupon can be redeemed). This real-time determination of whether the coupon is valid prior to crediting the consumer is one important factor that distinguishes the invention over the art of record. To aid in understanding the legal errors in the rejections, it is important to understand the differences between: i) determining whether a product is

"coupon eligible" and whether the coupon itself is valid; ii) in-store validation *prior to crediting* the consumer with the value associated with the coupon and *after the fact* processing by a coupon redemption center; iii) consumer fraud (e.g., unauthorized copying of coupons) and retailer fraud (which involves other well known issues) CITE; and iv) counting the number of times a coupon (or a copy thereof) is redeemed and limiting the number of coupons that can be printed in the first place.

As detailed below, the references the Examiner relies on relate primarily to coupon eligibility, after the fact processing by a redemption center, retailer fraud and/or limiting the number of times a coupon can be printed. None of the references relied on disclose in-store validation *prior to crediting* the consumer with the value associated with the coupon.

Independent claims 1, 11 and 16 recite similar features. Claim 1 and 16 are written in a means-plus-function format pursuant to 35 U.S.C. § 112, ¶6. Specifically, claim 1 and 16 recite "a database of coupon information, including at least information about coupons available, consumer account information, and information for associating selected ones of the available coupons with consumer accounts." See Specification *e.g.,* FIG. 1 and FIG. 8; and pg. 47 lines 8-17. The claim further recites "means, located at a retail store, for accessing the database" (corresponding structure is found at least at Fig. 2 element 132; pg. 46, lines 5-20; Fig. 8, element 810; and pg. 48, lines 1-9), "means for accessing the database including, input means for enabling a consumer to enter account information (corresponding structure is found at least at pg. 33 lines 2-5 and pg. 33 line 28-pg. 34 line 3), "display means for displaying information about the coupons available to the consumer account" (corresponding structure is found at least at pg. 32, line 26- pg.

33, line 5 and pg. 33, line 22- pg. 34, line 3), "selection means for enabling the consumer to select desired ones of the coupons based on the displayed information" (corresponding structure found at least at pg. 33, line 6-21), "a printer, located at the retail location of printing the selected coupons" (See at least pg. 33, lines 10-14), "redemption means, at the retail location, including a scanner for scanning coupons at the retail location checkout" (corresponding structure found at least at pg. 37, line 11- pg. 38, line 10 and pg. 44, lines 16-24), and "means for determining if a coupon presented by consumer is valid prior to crediting the consumer with a redemption valid associated with the coupon" (corresponding structure found at least at pg. 45, lines 15-22).

Dependent claim 2 is written in a means-plus-function format pursuant to 35 U.S.C. § 112, ¶6. Specifically, claim 2 recites, "means for accessing comprise a keyboard" (corresponding structure found at least at pg. 33, lines 6-14).

Dependent claim 4 is written in a means-plus-function format pursuant to 35 U.S.C. § 112, ¶6. Specifically, claim 4 recites, "means for counting a number of times the consumer redeemed a particular coupon" (corresponding structure found at least at pg. 45, lines 15-22; pg. 32, lines 14-16; pg. 34, lines 15-24) and "fraud detection means for indicating fraud if the number of time a coupon is redeemed by the consumer exceeds a predetermined amount" (corresponding structure found at least at pg. 32, lines 11-19; pg. 34, lines 10-14; pg. 37, lines 11-20; pg 39, lines 16-28; pg. 38, lines 4-10; and pg. 49, lines 5-14).

Dependent claim 6 is written in a means-plus-function format pursuant to 35 U.S.C. § 112, ¶6. Specifically, claim 6 recites, "redemption means retrieves coupon

information from said database" (corresponding structure found at least at pg. 37 lines 11-20 and pg. 38 lines 4-6).

Dependent claim 7 is written in a means-plus-function format pursuant to 35 U.S.C. § 112, ¶6. Specifically, claim 7 recites, "means for accessing comprise a coupon diskette" (corresponding structure found at least at least at pg. 33, line 28-pg.34 line 3).

Dependent claim 8 recites "said computer diskette contains data from said remote computer network entered on said computer diskette prior to use of said in-store redemptions system" (See at least pg. 35 lines 5-13).

Dependent claim 13 recites "determining if a coupon presented by a consumer is valid comprises accessing the database in real-time" (See at least pg. 43 lines 15-22).
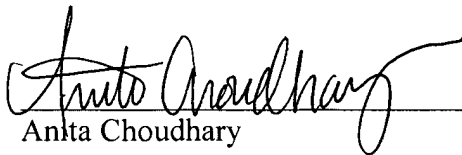
Dependent claim 27 is written in a means-plus-function format pursuant to 35 U.S.C. § 112, ¶6. Specifically, claim 27 recites, "the retail location checkout having means for gathering coupon data and mean for transmitting coupon data directly to manufacturer" (corresponding structure found at least at pg. 44 line 25- pg. 45, line 6.)

REMARKS

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: **April 27, 2006**   Respectfully submitted,

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